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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,345	06/22/2001	Michael Gary Platner	030950.0004.UTL	8906

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12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,345

Applicant(s)

PLATNER ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4 - 28 and 30 - 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4 - 28 and 30 - 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4-19-05 has been entered.

Response to Amendment

Applicant amendment of 4-19-05 amended the specification and claims 2, 4, 5 – 17 and 27 as well as traversed rejections of claims 2, 4 – 28 and 30 – 31 and cancelled claims 1, 3 and 29.

Currently, claims 2, 4 – 28 and 30 - 31 are pending.

Claim Objections

Claim 1 is objected to because of the following informalities: the phrase beginning after the phrase/active step “providing an online product to said user” should be moved for readability and particularly for scope determination to follow the second active step and specifically following the phrase “for tracking purposes”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 17 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, the applicant's specification did not describe the enabling of the recited process "wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at a time of the providing at least one of said plurality of certificate from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser". Moreover, the understanding of the applicant's invention is impeded significantly by the confusing and contradictory definitions through out the specification, which is exacerbated by excessive alternative language. In this regard, it is extremely difficult to determine the meaning of the words in the claims and thereby making the determination of scope almost impossible for one of ordinary skill.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 17 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 5 for example, the phrase "wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at a time of the providing at least one of said plurality of certificate from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser" is a relative phrase, which renders the claims indefinite. The phrase "wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at a time of the providing at least one of said plurality of certificate from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser" is not defined by the specification nor does specification provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For examination purposes the phrase "wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at a time of the providing at least one of said plurality of certificate from said purchaser to said user, information associated with said user is not provided to an entity that

provided said plurality of certificates to said purchaser" will be treated as a generic phrase and occurring offline.

Claims 5, 17 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In Claim 5 for example, the word "entity" is a relative word, which renders the claims indefinite. The word "entity" is not defined by the claim(s), the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. For example in the specification the applicant defines "entity" as both a user and purchaser at page 9. In that regard and in these claims, is the "entity" a purchaser or user or a web site owner/operator? For examination purposes the word "entity" will be treated as a generic word.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 5 - 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seidman (5,080,364) in view of Messner (US 6,370,514 B1) and further in view of Official Notice.

Regarding claim 5, Seidman teaches a method comprising steps of receiving payment for a certificate comprising an authorization code, providing said certificate to user, wherein said authorization code is assisted with at least one characteristic that is recorder for tracking purposes, wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at time of the sale of said certificate to said user, information associated with said user is not provided to an entity that provided said certificate to said user (see at least Abstract, Col 1, lines 24 – 30 and 61 – 64, Col 2, lines 1 – 4 and lines 65 – 68). Please note that Seidman discloses an establishment such as retailer with products incorporating a coupon. In that regard, it is old and well known that the retailer purchases these products from a supplier/vendor, which incorporate as taught by Seidman in a coupon. In this regard, the package supplier sells the certificate to the purchaser/establishment and in turn, the establishment sells the package with certificate(s) to the user/customer.

Although Seidman does disclose a machine readable coupon for tracking purposes, Seidman does not specifically disclose a method of providing a website associated with said certificate over a system of networked computers, receiving entry of said authorization code on said website, wherein authorization code had been entered on said website by said user and providing an online product to said user.

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On the other hand, Messner teaches a method of providing a website associated with said certificate over a system of networked computers, receiving entry of said authorization code on said website, wherein authorization code had been entered on said website by said user and providing an online product to said user (see at least Abstract, Col 3, lines 36 – 49 and Col 4, lines 1 – 9).

With regard to the phrase “wherein said certificate is sold to a purchaser and said purchaser sells said certificate to said user, and wherein at a time of the providing at least one of said plurality of certificate from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser”, the Examiner takes Official Notice that this type transaction does take place offline regularly. For example, “scalping” of certificates/tickets occurs regularly and the information is not provided to the entity that sold the certificate/ticket. Moreover, the wording of the phrase is so convoluted as to not make reasonable sense to one of ordinary skill in the art. As an example, why would a user who has received a product such as a certificate – sell this to a purchaser who in turn sells the certificate back to the user who just sold it them?

Regarding claim 2, the recitations that “wherein said online product comprise an online product related to the funeral industry”, such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “online products” already disclosed by Messner (Col 8, lines 17 - 18).

Regarding claim 4, Messner teaches a method, wherein said certificate is purchased online by said user (Abstract).

Regarding claim 6 (Original), Messner teaches a method, wherein said certificate is not redeemable for cash (Col 3, lines 36 – 46).

Regarding claim 7 and related claim 18 (Original), Messner teaches a method, wherein said certificate comprises a physical certificate (Col 1, line 40 – 41).

Regarding claim 8 and 9 (Original), Seidman teaches a method, wherein said certificate comprises a free certificate (Col 1, 34 - 36).

Regarding claim 10 (Original), Messner teaches a method, wherein said certificate comprises a nonfree certificate allowing said user to obtain said online product at a reduced fee (Col 12, lines 34 – 35).

Regarding claim 11 (Original), the recitation that “wherein said certificate allows said user to rent software via an application service provider for a specified time period”, such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “certificates” already disclosed by Messner.

Regarding claim 12 and related claim 23, Messner teaches a method, wherein said online product is an online service (Col 8, lines 17 – 18).

Regarding claim 13, Messner teaches a method, wherein said online product is customized to include information relating to said purchaser (Col 8, lines 17 – 18).

Please note that Messner does not specifically disclose customizing products online. Messner does disclose products and Messner further discloses customization (Col 3, lines 41 – 42). Moreover, it was old and well known to one of ordinary skill in the art at the time of the applicant's invention that online systems for customizing products for the purchaser as well as the user were used extensively and include products such as ecards. This customizing of products will increase shopping options and save time too and thereby increase customer satisfaction, which will increase the probability that the user will purchase more products.

Regarding claim 14, Messner teaches a method, wherein a plurality of purchasers provide certificates to users and said online product is customized to reflect information relating to said purchaser (Abstract and Col 8, lines 42 –46).

Regarding claim 15, Messner teaches a method, wherein said authorization code is unique (Col 4, lines 1 – 9).

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Seidman and Messner as applied to claim 5 above, and further in view of Walker (US 2002/0178071 A1).

The combination of Seidman and Messner discloses and teaches substantially the applicant's invention.

However, the combination does not specifically disclose a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user. Nor does the combination specifically disclose a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

Regarding claim 16, Walker teaches a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user (Abstract and Figure 1A). Please note that Walker does not specifically disclose reselling certificates such as coupons. However, Walker does disclose reselling products. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Walker with a method for reselling certificates such as coupons. In this manner, the purchaser can use these incentives to increase their sales.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Seidman and Messner with the method of Walker to have enabled a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user; and further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product – in order to provide additional offers of certificates such as coupons. The combination discloses a method comprising the steps of and as recited in claim 5. Walker discloses in the same area of online methods with coupons a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product (Abstract, Para 055 and Figure 1A). Therefore, one of ordinary skill in the art would have been motivated to extend the combination of Seidman and Messner with a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

Claims 17 – 20 and 21 – 28 and 30 - 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Giftcertificates.com web pages captured via the WayBackMachine (archive.org) in view of Official Notice.

Regarding claim 17 and related claim 27, Giftcertificates teach a method of: receiving payment for a plurality of certificates; providing said plurality of certificates to a purchaser, each of said certificates comprising an authorization code, wherein said authorization code of each of said plurality of certificates is different, and further wherein said plurality of certificates are redeemable for an online product at a no fee; providing one of said plurality of certificates from said purchaser to a user, wherein at a time of the providing at least one of said plurality of certificates from said purchaser to said user, information associated with said user is not provided to an entity that provided said plurality of certificates to said purchaser; providing a web site associated with said certificate over a system of networked computers; receiving entry of said authorization code on said web site by said user; providing said online product to said user at no fee in response to said step of entering said authorization code (see at least pages 1 - 4).

While Giftcertificates discloses certificates and a Supercertificate, the reference does not specifically disclose and teach each certificate –whether a “super” or single certificate containing different codes.

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On the other hand, the Examiner takes official notice that purchaser can buy additional certificates for different recipients/users in order to satisfy numerous "giving" requirements and each of the certificates would contain a different code. Thereby, it would have been obvious to one of ordinary skill in the art at the time of the invention to have extended the method of Giftcertificates with the purchase of a plurality of Supercertificates, which contain different authorization codes. In this regard, the purchaser can purchase for a number of users.

Regarding claims 18, Giftcertificates teaches a method wherein a said plurality of certificates comprises physical certificates (Page 3). Please note that Giftcertificates does not specifically disclose a physical certificate. However, Giftcertificates does disclose sending an email including the Supercertificate, which can be the email address of the purchaser. In that regard, the purchaser can print out to include in a card being mailed to user in order to provide a more personalized response than an email.

Regarding claims 19, 22 and 23 the recitations that "wherein said online product comprise an online product related to the funeral industry or "wherein second online product is an online product or service", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "online products" already disclosed by Giftcertificates (page 2).

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Regarding claim 20, the recitation that "giving said at least one of said plurality of certificates from said user to said second user", such recitations are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "giving (of gift certificates)" already disclosed by Giftcertificates. Moreover, "giving" is well known in everyday life and thereby this free choice that one makes of choosing to "give" is done everyday. Therefore, these choices of "giving" recited in the claim, which are made every day by millions of individuals is given very little patentable weight.

Regarding claim 24 and 25, Giftcertificates teaches a method wherein authorization code is associated with characteristics of said purchaser (pages 2 - 4).

Regarding claim 26 and related claims 30 and 31, Giftcertificates teaches a method wherein online product is customized (page 4).

Regarding claim 28, Giftcertificates teaches a method, wherein said authorization code is associated with characteristics that recorded for tracking purpose (Page 4).

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giftcertificates as applied to claim 17 above, and further in view of Walker (US 2002/017801 A1).

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The method of Giftcertificates discloses and teaches substantially the applicant's invention.

However, Giftcertificates does not specifically disclose a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user. Nor does the combination specifically disclose a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

Regarding claim 21, Walker teaches a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user (Abstract and Figure1A). Please note that Walker does not specifically disclose reselling certificates such as coupons. However, Walker does disclose reselling products. In that regard, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Walker with a method for reselling certificates such as coupons. In this manner, the purchaser can use these incentives to increase their sales.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method of Giftcertificates with the method of Walker to have enabled a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user; and further comprising: providing a commission to said

entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product – in order to provide additional offers of certificates such as coupons. Giftcertificates discloses a method comprising the steps of and as recited in claim 17. Walker discloses in the same area of online methods with coupons a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product (Abstract, Para 055 and Figure 1A). Therefore, one of ordinary skill in the art would have been motivated to extend the method of Giftcertificates with a method wherein said certificate is sold to a purchaser and said purchaser sells certificate to said user and a method further comprising: providing a commission to said entity; purchasing a second online product by said user; and providing a second commission to said entity as well as wherein said second online product is the same as the first online product.

Response to Arguments

Applicant's arguments with respect to claims 2, 4 – 28 and 30 - 31 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **571.272.6761**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **571.272.7159**.

Any response to this action should be mailed to:

Commissioner for Patents

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or faxed to:

(703) 872-9306 [Official communications; including

After Final communications labeled

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For general questions the receptionist can be reached at

571.272.3600

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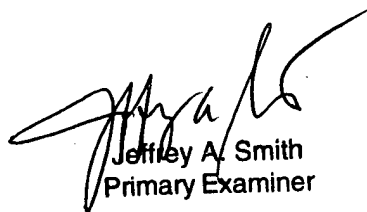
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Jeffrey A. Smith
Primary Examiner